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EXAMINER

BARQADLE, YASIN M

ART UNIT PAPER NUMBER

2153

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/852,848	Applicant(s) ARNESON ET AL.	
	Examiner Yasin M. Barqadle	Art Unit 2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Applicant's arguments filed on **April 03, 2006** have been considered but are not deemed persuasive.

- Claims 1-33 are presented for examination.

Response to Arguments

2. Applicant argues that "the examiner acknowledged that O'Neal disclosed a system answering a call and subsequently terminating the call not disclosing or suggesting a process server/system/second device performing any function without answering a call in response to a call" page 12, second paragraph. Examiner notes that O'Neal teaches "In addition, the present invention has been characterized in terms the interception and service of calls to long-distance numbers that utilize real-time audio, i.e., voice, as a communication means. However, it is within the scope of the present invention to provide local intercept and service of other forms of communications such as facsimile or other electronic text forms. Utilizing the efficiency of a data-centric network for transfer of electronic information such as facsimile results is greater

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cost savings to a long-distance customer. In this case, a local POP may merely detect electronic signals (such as fax tones) from an originating device and automatically switch to voicemail message mode. Following this, the call is terminated the obtained data is transferred as a burst over the data-centric network." Further, O'Neill teaches terminating the connection with the caller and automatically delivering the electronic file (voice message or other electronic text forms) over a data network to a recipient (col. 5, lines 36-42; col. 11, lines 38-67 and col. 14, 43-56). Terminating a call does not necessarily mean the call is completed. Because if the call is completed or connected, there would be a charge and that is what O'Neal is trying to avoid. (see abstract; Col.5, lines 36-42 and col. 10, lines 20-26. see also col. 11, lines 54-65). Therefore, O'Neal meets Applicant's limitation as understood by the Examiner. As for the rest the arguments see the previous response to the same arguments.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1,7,9,15,22, 26 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner could not find the limitation of "a process server automatically providing information to a device/recipient without a process server/system/second device answering a call to the process server/system/second device", or its equivalence in the applicant's specification as originally filed. (see applicant's arguments in page 12-15 and independent claims 1,7,9,15,22, 26 and 30 for different variations of the above limitation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 1,7,9,15,22, 26 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation of "automatically providing information to a device/recipient without a process server answering a call from a communication device", because it attempts to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. See *In re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). In ¶ [0047] of the Applicant's published specification reads "While in this embodiment, the system 100 preferably identifies the caller between the first and the second ring, it will be appreciated that the system 100 can be configured to not answer any incoming telephone calls to the first phone number. Caller ID systems work by identifying the incoming call prior to the call being completed. By not picking up the incoming call, the system 100 can have a longer period of time to identify the caller. In telephony systems where airtime or other phone charges are only incurred when a telephone call is completed, the system 100 can thus have more time to identify the caller without actually having the caller incur telephone charges." This is not equivalent to "automatically providing information to a

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device/recipient without a process server answering a call from a communication device." This teaches that the system can be configured to not answer an incoming call within few rings to identify a caller and it is a well function for caller ID devices.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-16 and 19-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al USPN (5742668) in view O'Neal USPN. (6243444).

As per claim 1, Pepe et al teach a system for delivering information to a plurality of mobile recipients having mobile communications devices (PDA 30, Cellular phone 32 and pager 34) capable of receiving text messages, said system comprising:

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at least one process server (PCI 40, fig.3);

at least one memory comprising [database 44]:

a plurality of desired information listings (col.5, lines 33-63) corresponding to each of a plurality of recipients (subscribers), said plurality of desired information listings (types of services subscribed) including data indicative of information desired by each respective one of said plurality of recipients [col. 7, lines 11-27 and 47-59]; and

a plurality of telephone identification listings corresponding to said plurality of recipients [database 44 stores profiles containing service related information for mapping services to subscribers col.6, lines 11-27 and 47-59]; and

a telephone link (fig. 3, network 29 and 39) through which said plurality of recipients can initiate telephone calls to access said process server [col. 5, lines 22-30];

wherein said process server (PCI 40, fig 3) uses said plurality of telephone identification listings to identify a recipient upon said recipient initiating a call telephone call to said telephone link [col. 15, lines 30-42]; and

in response to said telephone call, said process server initiates a process whereby said desired information is

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automatically provided to said recipient [fig. 8, col. 14, lines 46-63 and col. 15, lines 9-12. See also col. 5, lines 31-44].

Although Pepe et al shows substantial features of the claimed invention, he does not explicitly show a system without answering a call transmitting information to a second device. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe et al, as evidenced by O'Neal USPN. (6243444).

In analogous art, O'Neal disclose whose invention is about a method for intercepting and servicing long-distance calls prior to incurring charges associated with routing long-distance call, disclose a telephony-centric network server that detects initiation of a long-distance call, the call is intercepted, thereby giving the caller the opportunity to send a voice mail message and automatically delivered to a recipient over the data centric network [Col.5, lines 36-42 and col. 10, lines 20-26. see also col. 11, lines 54-65]. Giving the teaching of O'Neal, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe et al by employing the method for intercepting and servicing long-distance calls prior to incurring charges of O'Neal. One ordinary skill in the art would do so because it provides an

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increased efficiency and cost saving for the caller [abstract and col. 10, lines 20-26].

As per claim 2, Pepe et al teach the system for delivering information to a plurality of mobile recipients having mobile communications devices capable of receiving text messages according to claim 1, wherein:

said process server identifies a caller ID of said recipient to identify said recipient (fig. 8, col. 14, lines 46-63) in a manner that reduces telephone charges otherwise incurred by said recipient in calling said telephone link [col. 21, 53-67].

As per claim 3, Pepe et al teach the system for delivering information to a plurality of mobile recipients having mobile communications devices capable of receiving text messages according to claim 1, further comprising:

an information transfer link through which said process server can send said desired information to said recipient [fig.3 and 8].

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As per claim 4, Pepe et al teach the system for delivering information to a plurality of mobile recipients having mobile communications devices capable of receiving text messages according to claim 1, wherein said information transfer link comprises:

a text messaging service associated with said process server to provide desired information for said recipient to said recipient in a text format upon initiation of a telephone call by said recipient to said telephone Link [col. 5, lines 22-30 and col. 10, lines 1-14]].

As per claim 5, Pepe et al teach the system for delivering information to a plurality of mobile recipients having mobile communications devices capable of receiving text messages according to claim 4, wherein said text messaging services comprises:

a text messaging service that permits delivery of text messages to said recipient via at least one of a pager and a cellular telephone [col.21, lines 40-65].

As per claim 6, Pepe et al teach the system for delivering information to a plurality of mobile recipients having mobile

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communications devices capable of receiving text messages according to claim 1, further comprising:

an interactive data access device that said process server may access in response to receipt of a telephone call from said recipient such that said process server can obtain desired information for said recipient [fig. 8, col. 14, lines 46-63 and col. 15, lines 9-12].

As per claim 7, Pepe et al teach the method of providing electronic mail notification to a communications device, comprising:

associating an electronic mail account with a first phone number (the number called by the subscriber) calling said first phone number from a communications device (subscriber portable device 32) [col. 21, 15-67]; and

automatically providing said electronic mail message to said communications device after said communications device calls said first phone number [col. 7, lines 30-46 and col. 21, lines 18-67].

As to the limitation of without a called device answering a call see the rejection in claim 1 above.

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As per claim 8, Pepe et al teach the method of providing electronic mail notification to a communications device according to claim 7, further comprising:

obtaining a communications device identifier when said communications device dials said first phone number, and using said communications device identifier to select said electronic mail message [col. 14, lines 46-63 and col. 21, 40-65].

As per claim 9, Pepe et al teach a method of providing information to a remotely located, portable communication device (PDA 30, Cellular phone 32 and pager 34, fig.4), comprising:

correlating at least one information unit represented by a text message maintained by a database system (col. 6, lines 47-59) with a first phone number of an information retrieval system and a second phone number of a remotely located, portable communication device [col. 4, lines 46-64];

calling said first phone number with said remotely located, portable communication device, wherein said information retrieval system having said first phone number identifies said portable communication device (Cellular phone 32) using said second phone number [col. 5, lines 31-63 and col. 21, lines 40-55];

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initiating and substantially immediately said call to said first phone number [col. 18, 30-40 and col. 21, 40-55];

retrieving said at least one information unit from said database system using said information retrieval system [col. 18, 30-40 and col. 21, 40-55]; and

automatically providing said information to said portable communication device using said second phone number [fig. 8, col. 14, lines 46-63 and col. 15, lines 9-12].

As to the limitation of without a called device answering a call see the rejection in claim 1 above.

As per claim 10, Pepe et al teach the method of providing information to a remotely located portable communication device according to claim 9 wherein said portable communication device, comprises:

a text messaging capable cellular telephone [fig. 3, cellular phone 32].

As per claim 11, Pepe et al teach the method of providing information to a remotely located, portable communication device according to claim 9, wherein identification of said portable communication device includes:

utilization of caller ID information [col. 6, lines 47-65 and col. 21, lines 60-67].

As per claim 12, Pepe et al teach the method of providing information to a remotely located, portable communication device according to claim 9, wherein:

termination of said call to said first phone number is performed after a first ring [col.12, line 56-65].

As per claim 13, Pepe et al teach the method of providing information to a remotely located, portable communication device according to claim 9, wherein:

each instance of providing information to said portable communication device incurs no marginal cost to a user of said portable communication device [col. 21, 53-67].

As per claim 14, Pepe et al teach the method of providing information to a remotely located, portable communication device according to claim 9, wherein:

providing information to said portable communication device from said database system via said information retrieval system occurs only once in response to each incidence of calling said first phone number from said portable communication device [col.21, lines 40-67].

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As per claim 15, Pepe et al teach a method of providing database access (database 44), comprising:

associating a first piece of information with a first communications device identifier in a system [col.6, 34-59];

detecting a first communications device identifier when said first communications device is used to contact said system [the arrival of an email or a call is detected col. 10, lines 28-67];

retrieving said first piece of information in response to detection of said first communications device identifier [col. 10, lines 28-67]; and

automatically transmitting said first piece of information to said first communications device following retrieval of said first piece of information [fig. 8, col. 14, lines 46-63 and col. 21, 40-67].

As to the limitation of without a called device answering a call see the rejection in claim 1 above.

As per claim 16, Pepe et al teach the method of providing database access according to claim 15, wherein:

said first piece of information is associated with said first communications device identifier by designating a first piece of information as information that is to be transmitted to

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a telephone number assigned to said first communications device [col. 14, lines 46-63; col. 15, lines 9-12 and col. 21, lines 40-67].

As per claim 19, Pepe et al teach the method of providing database access according to claim 16, wherein said detection of said first communications device identifier comprises:

identifying said telephone number of said first communications device when said first communication device contacts said system via telephony [col. 15, lines 30-42].

As per claim 20, Pepe et al teach the method of providing database access according to claim 19, wherein said identification of said telephone number of said first communications device comprises:

using caller ID to identify said first communications device prior to a telephone connection being established between said communications device and said system [col. 6, lines 47-65 and col. 21, lines 60-67].

As per claim 21, Pepe et al teach the method of providing database access according to claim 19, wherein said transmission

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of said first piece of information to said first communications device comprises:

 sending a text message to said first communications device using said telephone number of said first communications device [col. 5, lines 31-63].

As to claims 22,26 and 30, these claims have similar limitations as claim 1 and 15, therefore, they are rejected with the same rationale.

As to claims 23-25, 27-29 and 31-33, these claims have similar limitations as to claims 1-6. Therefore, they are rejected with the same rationale.

2. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al USPN (5742668) in view in view O'Neal USPN. (6243444) and further in view of Yeh et al US Pub. (2004/0162747).

Regarding claims 17 and 18, although Pepe et al and O'Neal show substantial features of the claimed invention as explained in claims 1 and 15 above, they do not explicitly show designating a

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selected stock quotation to be transmitted to a first communication device.

Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Pepe et al and O'Neal, as evidenced by Yeh et al US Pub. (2004/0162747).

In analogous art, Yeh et al whose invention is about integrated interactive telephone and computer network communications system, disclose designating a selected stock quotation to be transmitted to a subscriber (telephone number) communication device [¶ 0053 and 0059]. Giving the teaching of Yeh et al, a person of ordinary skill in the art would have readily recognized the desirability and the advantage of modifying Pepe et al and O'Neal by employing the system of Yeh et al because it would give immediate desirable information to a user having a portable communication device at any location.

Conclusion

The prior made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yasin

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Barqadle whose telephone number is 571-272-3947. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR system. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YB

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ABDULLAHISALAD
PRIMARY EXAMINER